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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FERKO, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/725,048

Applicant(s)

BAZIN ET AL.

Examiner

Kathryn Ferko

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

This is a response to the amendment filed November 14, 2002. Claims 1-62 are pending.

### *Claim Rejections - 35 USC § 112*

The 35 U.S.C 112 rejection has been withdrawn.

### *Response to Arguments*

1. Applicant's arguments filed November 14, 2002 have been fully considered but they are not persuasive.

Applicant's arguments have been carefully reviewed and noted. However, page 15 of the current specification recites, "For example, the transfer member could include either adhesive material provided on a backing, a sheet of absorbent material, a piece of fabric, an article of fabric clothing (i.e., a blouse), a piece of moldable material, a hair brush or comb, **or even a portion of the scanner 12, such as a window defining a scanning region 32, as shown in Fig. 5.**" Additionally, figure 8 shows an arm being placed directly on the scanner. Furthermore, claim 16, for example states, "...the external portion of the individual is placed into contact with the scanning region of the scanner." Therefore, the transfer member is **a portion of the scanner such as a window defining a scanning region**. This corresponds to that stated in the rejection. As stated in the arguments on page 7, "Scott et al., disclose a scanner ... this reference discloses directly scanning one or more fingers placed in contact..."

Therefore, the *transfer member is a portion of the scanner such as a window.*

Again, the transfer member in Herzog and Rigg et al. is a portion of the scanner such as a window.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 12, 14-16, 21-22, 25-27, 30-32, and 50-54 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Scott et al.

Scott et al. disclose a process for acquiring scanned image data relating to an external body portion or a product applied to the external body portion by placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member; scanning the transfer image with an optical image scanner (10) to obtain scanned image data for an

Art Unit: 3743

image representative of at least one characteristic of the external body portion or at least one product applied to the external body portion; a transfer member that is a window, the window being a portion of the image scanner defining a scanning region; placing the external portion of the individual in the vicinity of a scanning region of the scanner, and scanning the external portion with the image scanner; wherein the scanning of the transfer image of the transfer member and the scanning of the external portion occur one of simultaneously and one after another; an external portion of the individual is placed into contact with the scanning region of the scanner; a scanner that is a flat bed scanner and wherein the external portion of the individual is moved into contact with the scanning region; an external portion that includes at least one of the skin of the individual, at least one strand of hair of the individual, at least one fingernail of the individual, at least one toe nail of the individual, and at least one tooth of the individual; an external portion that is located on one of the hand, foot, arm, leg, torso, and face of the individual; an image scanner that is associated with a first computer (14) located at a first location; transferring the scanned image data from the first computer to a second computer located at a second location remote from the first location, as seen in figure 1; transferring that includes transmitting the scanned image data via the Internet, as seen in figure 1; storing the scanned image data on a data storage medium (26), wherein the transferring includes shipping the data storage medium to the second location, which is the way to ship a fingerprint card; displaying an image corresponding to the scanned image

data and viewing the displayed image to analyze said at least one characteristic; displaying the image at the second location, as recited in column 3, lines 37-65; sending the scanned image data to a plurality of locations so that the at least one characteristic may be analyzed numerous times, as recited in column 3, lines 50-52; scanning that includes emitting light from the scanner onto the transfer member; a calibration member having one of a predetermined size and a predetermined color, as recited in column 5, lines 19-30; obtaining scanned image data relating to multiple scanned images; and a transfer image on the transfer member that indicates a condition of the external portion.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 9-26, 30-40, 43-46, and 49-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzog.

Herzog discloses a process for acquiring image data relating to an external body portion or a product applied to the external body portion by placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member; scanning the transfer image with an optical image scanner (16, 1, 2, 3, 4) to obtain scanned image data for an image representative of at least one characteristic of the external body portion or

at least one product applied to the external body portion, wherein although the disclosure discusses placing documents on the scanner and using the video recorder for obtaining human images, it is within the scope of the invention to use the scanner for obtaining human scanning information. Herzog also discloses a transfer member that is a window, the window being a portion of the image scanner defining a scanning region and a scanner that is a flat bed scanner, as seen in figure 1; an image scanner that is associated with a first computer located at a first location, and wherein the process further comprises transferring the scanned image data from the first computer to a second computer located at a second location remote from the first location, as recited in column 4, lines 6-25; transmitting the scanned image data via the Internet, as recited in column 4, line 22; viewing the displayed image to analyze said at least one characteristic; transferring the scanned image data from the first computer to a second computer at a second location remote from the first location, wherein the image is displayed at the second location; sending the scanned image data to a plurality of locations so that the at least one characteristic may be analyzed numerous times; monitoring the status of the external portion during treatment of the external portion; providing a recommendation for a treatment of the external portion based on the monitored status, as stated in column 2, lines 1-9; providing the individual with information regarding the effectiveness of the treatment (inherent); repeating at least the acquiring (also inherent); image data that is stored in an image database, as recited in column 2, lines 48-51; determining a

recommendation of at least one treatment for the external portion and providing the treatment recommendation so that the external portion of the individual may be treated according to the recommendation, as recited in column 3, lines 40-50, wherein the treatment recommendation may be a recommendation regarding use of at least one of a cosmetic product and a dermatological product; recommendation that includes providing the treatment recommendation to at least one of the individual and a treatment provider; recommendation that includes transmitting said recommendation to said at least one of the individual and the treatment provider via the Internet; image data that includes data regarding color of said transfer image; scanning that includes emitting light from the scanner onto the transfer member; a scanner is configured in the form of a scanner for scanning documents; scanned image data relating to multiple scanned images; a transfer image on the transfer member that indicates a condition of the external portion; and analyzing of the external portion is performed by a trained person. Additionally, although not explicitly recited, a transfer member that includes adhesive material provided on a backing, the adhesive material of the transfer member being placed in contact with skin and the transfer member being removed from the skin to transfer cells from the skin of the individual to the transfer member and a transfer member that is in contact with adhesive material of a second transfer member and separating the transfer members to transfer a portion of the skin cells to the second transfer member are well known processes. Therefore, it would be obvious to one with ordinary skill in



the art at the time the invention was made to use an adhesive material such as tape to obtain samples to scan images of items that could not be directly placed on that scanner. Furthermore, it is also within the scope of the invention to have a transfer member that is a sheet of material, and wherein sheet of material is placed in contact with lips of the individual and transferring a lip product from the lips to the sheet of material and a lip product that is lipstick, in which the lipstick could be used as a coloring medium to better transfer the image for medical analysis. Also, a transfer member that is a moldable material, and wherein the process includes placing the moldable material in contact with the skin of the individual to produce, on the moldable material, the surface profile of the skin; a transfer member is one of a hair comb and a hair brush, wherein the placing of the transfer member in contact with the external body portion includes passing said one of the hair comb and the hair brush through hair, wherein the transfer image on the transfer member includes at least one of strands of hair and skin cells would also be obvious to one with ordinary skill in the art as methods to obtain scans of those types. Furthermore, the inherent way to use a flat scanner as seen in figure 1 is to place the external portion of desired scanned image in the vicinity of a scanning region of the scanner, scanning the external portion with the image scanner, wherein it is within the scope of the invention to have a human be scanned, wherein the scanning of the transfer image of the transfer member and the scanning of the external portion occur one of simultaneously and one after another and the individual is placed into contact with the scanning

region of the scanner. It is also within the scope of the invention to have the scanner be hand-held. Moreover, placing liquid between the external body portion and the scanning region, the liquid altering the index of refraction to improve visualization of said at least one characteristic and placing at least one of a dye; a pigment on the external portion to improve visualization of said at least one characteristic; a transfer member that is configured to change color in response to a condition of the external portion; and treating at least one of the transfer member and the external body portion to enhance the transfer image on the transfer member are well known techniques often used with microscopes. Therefore, it would be obvious to one with ordinary skill in the art to utilize them with the scanner when scanning images similar to those obtained from a microscope. Although not explicitly recited, it is within the scope of the invention to have the external portion include at least one of the skin of the individual, at least one strand of hair of the individual, at least one fingernail of the individual, at least one toe nail of the individual, and at least one tooth of the individual; a location on one of the hand, foot, arm, leg, torso, and face of the individual; a location on the lips of the individual; at least one strand of hair that is one of a strand of hair from the scalp of the individual, an eyelash of the individual, and an eyebrow hair of the individual. Additionally, a computer that at least partially performs the determining of the treatment recommendation, the computer being located at a location remote from that of the image scanner would be feasible since the server could provide comparative data. A calibration member having

one of a predetermined size and a predetermined color would also be obvious to one with ordinary skill in the art. Furthermore, analyzing at least one of the external body portion and the transfer member with analysis equipment where the analysis equipment is chosen from one of a corneometer, a dermal torque meter, an image analyzer, a PH meter, and a device for measuring hydration of the skin is also within the scope of the invention.

6. Claims 1-10, 12, 14-16, 18, 27-30, 38-43, 46-50, and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rigg et al.

Rigg et al. disclose a process for acquiring scanned image data relating to an external body portion or a product applied to the external body portion, by placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member; and scanning the transfer image with an scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion, as recited in column 2. Rigg et al. also disclose a transfer member that is a window, the window being a portion of the image scanner defining a scanning region; placing the external portion of the individual in the vicinity of a scanning region of the scanner; scanning the external portion with the image scanner; a transfer member and the scanning of the external portion that occur one of simultaneously and one after another; the individual is placed into contact with the scanning region of the scanner; a scanner that is a hand-held scanner wherein the scanner is moved into contact

with the external portion of the individual, as seen in figure 1; storing the scanned image data on a data storage medium (36), wherein the transferring includes shipping the data storage medium to the second location, as recited in column 5 and seen in figure 1; sending to the second location at least one of billing information and payment information; determining a recommendation of at least one treatment for the external portion; providing the treatment recommendation so that the external portion of the individual may be treated according to the recommendation; a treatment recommendation that is a recommendation regarding use of at least one of a cosmetic product and a dermatological product; at least one of the cosmetic product and the dermatological product is one of a makeup product, a care product, a hair product, a skin product, and a sun exposure product; a treatment recommendation that is a recommendation regarding application of said at least one of the cosmetic product and the dermatological product to the external portion; providing product ordering information along with the treatment recommendation; providing the treatment recommendation to at least one of the individual and a treatment provider; scanned image data includes data regarding color of said transfer image; scanning that includes emitting light from the scanner onto the transfer member, as recited in column 3, lines 10-20; analyzing the external portion, wherein the analyzing of the external portion is performed by a trained person; an external portion that includes skin wherein the cosmetic product is foundation makeup; and storing information relating to the grade in a database. Although Rigg et al.

do not disclose an optical image scanner, it would be obvious to one with ordinary skill in the art at the time the invention was made to substitute the scanner of Rigg et al. with an optical scanner for the purpose of obtaining more information. Additionally, a transfer member that includes an adhesive material provided on a backing, the adhesive material of the transfer member being placed in contact with skin and the transfer member being removed from the skin to transfer cells from the skin of the individual to the transfer member and placing the adhesive material of the transfer member in contact with adhesive material of a second transfer member and separating the transfer members to transfer a portion of the skin cells to the second transfer member wherein the transfer member is placed in contact with an external body portion including a cosmetic product applied thereto, wherein the image of the scanned image data is representative of at least one characteristic of the cosmetic product; an external portion that includes lips and wherein the cosmetic product is one of a lip care product and a lip makeup product; a transfer member that is formed of fabric; a transfer member that is an article of clothing; a transfer member is a sheet of material, and wherein the process includes placing the sheet of material in contact with lips of the individual and transferring a lip product from the lips to the sheet of material, wherein the lip product is lipstick; an external portion that is located on the lips of the individual; transferring a questionnaire answers from the first location to the second location, at least some of the questionnaire answers being related to at least one of a condition of the external portion and the product

applied to the external body portion; a transfer member that is placed in contact with an external body portion including a cosmetic product applied thereto, and wherein the scanned image data is representative of at least one characteristic of the cosmetic product; and providing a grade indicative of at least one of the condition and performance of the product, they are features/modification that would be obvious to one with ordinary skill in the art at the time the invention was made. It would be obvious to incorporate a flat scanner to include the ability to obtain other cosmetic information and provide additional products.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Ferko whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KF  
February 17, 2003

  
Henry A Bennett  
Supervisory Patent Examiner  
Group 3700